REMARKS

With the above amendments, claims 1, 3-5, 7-11, and 13-22 remain in the application. Claims 2, 6, and 12 have been canceled in this response.

Objection To The Specification

The disclosure is objected to for including an embedded hyperlink and/or other form of browser executable code. Applicants respectfully traverse the objection because Applicants do not intend to have those hyperlinks be active links. Also, the "hyperlinks" are actually mere domain names and are necessary to explain the embodiments to comply with the requirements of 35 U.S.C. § 112, first paragraph. See MPEP 608.01 VII, Examiner Note 4.

Claim Rejections -- 35 U.S.C. § 112 and § 101

Claim 7 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite and under 35 U.S.C. § 101 as directed to non-statutory subject matter. Claim 7 has been amended to claim elements in computer-readable storage medium to overcome the §§ 101 and 112 rejections.

Claim Rejections -- 35 U.S.C. § 102

Claims 1-10 and 12-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,216,112 to Fuller et al. ("Fuller"). The rejection is respectfully traversed.

Claim 1 is patentable over Fuller at least for reciting: "the delivery of advertising to the computer **not inextricably tied to any particular member item** and continues **regardless of which member item is in the computer** and so long as any member item is detected as being present in the computer" (emphasis added) (Specification, page 7, line17 to page 8, line 8). Claim 1 pertains to embodiments where the delivery of

advertising is not tied to any particular item. This advantageously allows for a more flexible advertisement delivery as the provider does not have to rely on any particular item and does not have to continually update the engine used to deliver advertisements (Specification, page 11, lines 10-23).

Fuller, on the other hand, embeds advertisement delivery into a particular adware program. This is the exact same issue being addressed by embodiments of the present invention (Specification, page 1, line19 to page 2, line 2). In Fuller, advertisements are inserted into the adware program by means of hooks that are written directly into the binary executables of the adware program (Fuller, col. 2, lines 53-56; col. 3, lines 28-38; col. 7, lines 4-26). That is, advertisement delivery is directly tied to the particular adware in Fuller's disclosure. Therefore, it is respectfully submitted that claim 1 is patentable over Fuller.

Claim 1 is also patentable over Fuller at least for reciting: "delivering advertising to the computer even if no member item is being utilized in the computer." In Fuller, advertisements cannot be delivered to the computer unless the adware program is executed. This is readily apparent in Fuller FIG. 3, where step 332 of acquiring new advertisements depends on invocation of the adware program following step 300.

Fuller col. 3, lines 47-57, cited in the last office action, talks about updating of advertisements by plug-in but does not indicate whether or not the adware program needs to be invoked to do so. As evidenced in Fuller FIG. 3, Fuller does not allow for delivery of advertisements without running the adware program. Also, note that Fuller FIG. 4 follows from FIG. 3 and that the plug-in uploads data in step 410, which cannot occur unless the adware program is invoked following step 300 (Fuller FIG. 3). This is not surprising given that advertisement delivery is embedded in the adware program in Fuller's system.

Claim 1 is also patentable over Fuller at least for reciting: "the advertising delivered to the computer being selected based on a web page viewed by a user of the computer." This limitation of claim 1 was previously in claim 6. In the rejection of claim 6, the last office action suggests that users go to a web page to choose the

advertisement they want and advertisements are selected for different software. However, none of these suggestions show that Fuller discloses selection of advertisements based on a web page viewed by a user of the computer. Fuller does not even monitor the web pages viewed by a user to take advantage of that information in selecting advertisements to be embedded into an adware program. Fuller does not know the web pages viewed by a user especially before downloading of any adware to the user's computer. Therefore, it is respectfully submitted that claim 1 is patentable over Fuller.

Claims 3-5 depend on claim 1 and are thus patentable over Fuller at least for the same reasons that claim 1 is patentable.

Similar to claim 1, claim 7 is patentable over Fuller at least for reciting: "computer-readable program code for delivering a piece of advertising to the computer so long as the item remains in the computer and regardless of whether the item is being used, the delivery of the advertising to the computer not inextricably tied to any particular item in a group of items and continues regardless of which item in the group of items is present in the computer and so long as any member item in the group of items is detected as being present in the computer, the piece of advertising being selected based on a web page viewed by a user of the computer."

Claims 8-10 and 13 depend on claim 7 and are thus patentable over Fuller at least for the same reasons that claim 7 is patentable.

Claim 14 is patentable over Fuller at least for reciting: "providing additional member items to the user so long as the user retains at least one member item and regardless of whether the user is utilizing any member item, the providing of additional member items to the users not being inextricably tied to a particular member item." As discussed with reference to claim 1, advertisements cannot be delivered without utilizing the adware program and advertisements are tied to the adware program in Fuller's system.

Claims 15-22 depend on claim 14 and are thus patentable over Fuller at least for the same reasons that claim 14 is patentable.

Claim Rejections -- 35 U.S.C. § 103

Claim 11 stands rejected under 35 U.S.C. §103 as being unpatentable over Fuller. Claim 11 depends on claim 7. The patentability of claim 7 over Fuller has been explained above. Therefore, claim 11 is patentable over Fuller at least for depending on claim 7.

Conclusion

For at least the above reasons, it is believed that claims 1, 3-5, 7-11, and 13-22 are in condition for allowance. The Examiner is invited to telephone the undersigned at (408)436-2112 for any questions.

If for any reason an insufficient fee has been paid, the Commissioner is hereby authorized to charge the insufficiency to Deposit Account No. 50-2427.

Respectfully submitted,
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